

REMARKS

I. INTRODUCTION

Claims 1 to 4 and 6 to 14 are now pending. Reconsideration of the present application in view of the foregoing amendments and following remarks is respectfully requested.

II. REJECTION OF CLAIMS 1 TO 4 AND 6 TO 14 UNDER 35 U.S.C. § 112, 1st ¶

Claims 1 to 4 and 6 to 14 were rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Office Action asserts that the Specification lacks support for the features of claim 1 with respect to “said dissipative coating layer is applied onto all connecting cables of ESD sensitive devices.”

Applicant respectfully disagrees with the merits of this rejection since the original Specification provides an adequate written description of the subject matter claimed. For example, claim 5 of the originally-filed Specification states *verbatim* these features now recited in claim 1. Hence, the Specification as originally filed provides an adequate written description for the subject matter claimed. That is, the Specification as filed conveys with reasonable clarity to those skilled in the art that, as of at least the filing date of the present application, Applicant was in possession of the subject matter claimed, which is all that is required to satisfy the written description requirement under 35 U.S.C. § 112, first paragraph. Accordingly, it is respectfully submitted that claim 1, as well as dependent claims 2 to 4 and 6 to 14, comply with the written description requirement under 35 U.S.C. § 112, first paragraph.

Claims 1 to 4 and 6 to 14 were also rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. In particular, the Office Action asserts that these claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to claims 1 to 4 and 6 to 14 being rejected as non-enabling under the first paragraph of 35 U.S.C. § 112, the rejection is not understood. The Office Action states on page 3 that “[i]t is unclear for person of ordinary skill in the art the detail structure

of the dissipative coating layer applied onto all connecting cables of ESD devices.”

Applicant respectfully disagrees since the present application provides, for example, that:

Thickness of the dissipative coating layer ranges from about 5 μm to about 100 μm . Selected materials as a polymer of the dissipative coating layer need to be of compliance in the process of coating, and have a surface resistivity at range $10^6 - 10^{10} \Omega/(\text{square unit})$.

(Substitute Specification, page 3, lines 8 to 11). Accordingly, in view of the above, the enablement rejection is not understood and is plainly obviated by the foregoing text of the specification.

The Office Action appears to suggest that the above description is lacking because “no relevant detail of the dissipative coating layer applied onto all connecting cable of ESD sensitive devices, as claimed in the base claim 1, is either described in the specification as shown in the figure” (Office Action, page 3). It is respectfully submitted, however, that sufficient detail has indeed been provided, as exemplified above, and that further detail provided with respect to the dissipative coating layer is in the context of the ESD component may also apply to the connecting cables as well. It is therefore believed that Office Action's suggestion that the detailed description should provide further details may be misdirected.

Also in this regard, it is respectfully submitted that the Office Action's assertions and arguments presented simply do not reflect the standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention — which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d. 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the

nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner's analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01).

In contrast to the above, however, it is respectfully submitted that the Office Action's unsupported assertions simply do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as evidenced, for example, by the above reference to the present application. In short, the Office Action's assertions are believed to be conclusory and that they therefore do not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims — a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any “evidence or sound scientific reasoning” and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.).

Moreover, the Board made clear that it is “incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence,” and also made clear that “[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph.” (See *id.* at 1222 & 1223; italics in original). In the present case, the Office Action has not even alleged in a conclusory way that undue experimentation would be required. Moreover, even as to the assertions as presented, the present application plainly discloses how to make and/or use the subject matter of the rejected claims, as explained above.

In view of all of the foregoing, it is plain that the Office Action's assertions to support the rejections of the claims simply do not satisfy the judicial standards discussed above with respect to the enablement since the arguments and assertions presented do not relate the scope of the claims to the specification to determine whether the specification is enabling, nor do they properly address the enablement factors. It is therefore respectfully submitted that the Office Action has not even established a *prima facie* case as to the enablement requirement. It is therefore respectfully requested that the enablement rejections be withdrawn based on all of the foregoing.

III. REJECTION OF CLAIMS 1 TO 4 AND 6 TO 14 UNDER 35 U.S.C. § 112, 2nd ¶

Claims 1 to 4 and 6 to 14 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully disagrees for the following reasons.

As provided in M.P.E.P. § 2173.02, the “focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirement of clarity and precision.” In this regard, the “essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” *Id.* (emphasis added). “Definiteness of claim language must be analyzed, not in a vacuum, but in light of[, inter alia, the] content of the particular application disclosure[and the] claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” *Id.* If the claims, when read in light of the Specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the second

paragraph of 35 U.S.C. § 112 demands no more. M.P.E.P. § 2173.05(a) (citing Shatterproof Glass Corp. v. Libbey Owens Ford Co., 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985)).

As regards the contention by the Office Action that the recitation of “wherein said dissipative coating layer is applied onto all connecting cables of ESD sensitive devices” in claim 1 is unclear, Applicant respectfully disagrees and submits that, when read in light of the Specification, those skilled in the art would understand, with a reasonable degree of clarity and particularity, that the scope of the invention includes any and all dissipative coating layers that might be applied onto the connecting cables of ESD sensitive devices, and that the details of the exemplary dissipative coating provided in the specification apply to the connecting cables as well. Accordingly, Applicant respectfully submits that the claim language is both reasonably clear and precise as the subject matter permits.

In view of the foregoing, it is respectfully submitted that the claims fully comply with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

IV. OBJECTION TO THE DRAWINGS

The drawings were objected to under 37 C.F.R. § 1.83 (a) for allegedly not showing every feature specified in the claims. In particular, the Office Action asserts that “the detail of dissipative coating layer applied onto all connecting cables of ESD sensitive devices, as claimed in the base claim 1, must be shown or the features(s) canceled from the claim(s).” In this regard, it is respectfully submitted that a detailed showing of the dissipative coating layer applied onto all connecting cables is not essential for a proper understanding of the invention for at least the reasons explained above. That is, the details provided in the specification with respect to the dissipative coating layer are sufficient to establish that those skilled in the art, upon reading the specification and examining the figures, would understand the scope of the invention, as well as, how to make and/or use the invention.

In view of the foregoing, withdrawal of this objection is respectfully requested

V. REJECTION OF CLAIMS 1, 4, 6 AND 7 UNDER 35 U.S.C. § 103(a)

Claims 1, 4, 6 and 7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Japanese Patent Publication No. 02-17289 (“Kawakami”) in view of U.S. Patent No. 5,436,803 (“Annis”), U.S. Patent No. 5,245,613 (“Takami”), U.S. Patent No. 4,130,334 (“Anderson”) and U.S. Patent No. 4,406,059 (“Scott”).

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

Claim 1 relates to an electrostatic discharge device (ESD) safe wireless type of component, which includes a base, an electrically conductive copper trace and an insulation layer, in which a dissipative coating layer applied onto the top of the insulation layer and all connecting cables of ESD sensitive devices.

As admitted on page 6 of the Office Action, the primary Kawakami reference does not in any way disclose or suggest the features of claim 1 with respect to a dissipative coating layer applied onto all connecting cables of ESD sensitive devices. It is respectfully submitted that the Annis, Takami, Anderson and Scott references also do not disclose the features of claim 1 with respect to a dissipative coating layer applied onto all connecting cables of ESD sensitive devices. This is evidenced by the fact that the Office Action does not in any way identify the foregoing features in either Annis or Takami. Instead, the Office Action merely asserts on page 6 that “Annis et al., discloses conductive wires connected to a circuit board” and “Takami et al., disclose cable 17 connected to motherboard”, without regard to a dissipative coating layer. Additionally, the Office Action asserts on page 6 that FIG. 1 and col. 1, lines 12 to 17, of the Anderson reference disclose a cable having a shielding to avoid static discharge. However, the shielding referred to by the Anderson reference is actually a shielding conductor (a.k.a., the ground plane) located *within* the insulation of a flat cable, rather than a dissipative coating layer applied *onto* the flat cable, as required by claim 1. The Office Action also asserts on page 6 that Figure 6 of the Scott reference “teaches extending a coating onto the connection site”, but the Office Action does not in any way identify the alleged dissipative coating layer. Indeed, Scott makes no reference at all to a dissipative coating layer.

Accordingly, any review of Annis, Takami, Anderson and Scott makes plain that these references simply do not cure the critical deficiencies of the Kawakami reference with respect to the features of claim 1. It is therefore respectfully submitted that claim 1 is allowable over the references as applied.

The Office Action also asserts that “[a] person of ordinary skill in the art would recognize the advantage of providing antistatic coating to cable connection to have protection against static electricity during the manufacturing process/assembly or during use

of the device” and “[t]herefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant’s invention to provide connecting cables to the board of Kawakami et al., for input/output signal of various devices ... and to coat those cable connections with the dissipative coating”, but such assertions are clearly suggestions on the part of the Examiner alone with no supportive basis in the references cited.

In this regard, to the extent that the Examiner maintains the unsupported “ordinary skill” statements regarding those rejections, it is respectfully requested pursuant to 37 C.F.R. § 1.104(d)(2) that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also M.P.E.P. § 2144.03). Otherwise, if the Examiner cannot provide either references or an affidavit to support the contentions now made, it is respectfully requested that the rejections of the claims under 35 U.S.C. § 103(a) be withdrawn for this reason alone.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action’s generalized assertions that it would have been obvious to modify the references relied upon do not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon.

That is exactly the case here since the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify a reference in view of another reference to provide the claimed subject matter of the claims. Accordingly, the Office Action’s assertions in this regard are simply insufficient since the Office must provide proper evidence of a motivation or suggestion for modifying a reference in view of another reference to provide the claimed subject matter.

In short, there is no evidence whatsoever — except subjective speculation — that the references relied upon, whether taken alone, combined or modified, would provide

the features discussed above of any of claim 1. It is therefore respectfully submitted that claim 1 is allowable for these further reasons.

Claims 4, 6 and 7 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1.

In sum, it is therefore respectfully submitted that claim 1, and claims that depend from claim 1, including claims 4, 6 and 7, are allowable over the applied references for at least these reasons. Accordingly, the obviousness rejections of these claims should be withdrawn.

VI. REJECTION OF CLAIMS 2, 3 AND 8 UNDER 35 U.S.C. § 103(a)

Claims 2, 3 and 8 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of Annis and Takami, and in further view of U.S. Patent No. 5,350,228 ("Remington").

With respect to the rejection of claims 2, 3 and 8 under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of Annis and Takami, and in further view of Remington, it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the Remington reference does not cure the critical deficiencies of the Kawakami, Annis and Takami references (as explained above) with respect to claim 1, from which claims 2 and 3 depend. Indeed, the Office Action does not allege that Remington cures the deficiencies of Kawakami, Annis and Takami, as applied against claim 1. It is therefore respectfully submitted that claims 2, 3 and 8 are allowable for at least the same reasons that claim 1 is allowable. Accordingly, withdrawal of the obviousness rejection of claims 2, 3 and 8 is respectfully requested.

VII. REJECTION OF CLAIMS 9 TO 14 UNDER 35 U.S.C. § 103(a)

Claims 9 to 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of Annis and Takami, and in further view of U.S. Patent No. 6,459,943 ("Dodsworth").

With respect to the rejection of claims 9 to 14 under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of Annis and Takami, and in further view of Dodsworth, it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the Dodsworth reference does not cure the critical deficiencies of the Kawakami, Annis and Takami references (as explained above) with respect to claim 1, from which claims 9 to 14 depend. Indeed, the Office Action does not

allege that the Dodsworth cures the deficiencies of Kawakami, Annis and Takami as applied against claim 1. It is therefore respectfully submitted that claims 9 to 14 are allowable for at least the same reasons that claim 1 is allowable. Accordingly, withdrawal of the obviousness rejection of claims 9 to 14 respectfully requested.

VIII. REJECTION OF CLAIM 1 UNDER 35 U.S.C. § 103(a)

Claim 1 was rejected under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of Annis.

With respect to the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of Annis, it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the Annis reference does not cure the critical deficiencies of the Kawakami reference (as explained above) with respect to claim 1. Indeed, as explained above, the Office Action does not in any way identify the features in Annis of a dissipative coating layer applied to all connecting cables of a ESD sensitive devices, as admittedly not disclosed by Kawakami. It is therefore respectfully submitted that claim 1 is allowable for at least the same reasons discussed above. Accordingly, withdrawal of the obviousness rejection of claim 1 respectfully requested.

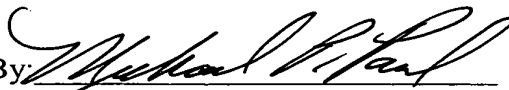
CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn since they have been obviated. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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